



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,809	07/08/2005	Shigeaki Matsunaga	2005_1101A	8156
513 7590 01/16/2009 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER BON, MING Y	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 01/16/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,809

**Applicant(s)**

MATSUNAGA, SHIGEKI

**Examiner**

MING HON

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9 December 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 8 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. The application filed on July 8, 2005 contained three patentably distinct species which are Species A: Music Reproduction Device; Figure 11A; Species B: Display Device; Figure 11B; Species C: Printing Device; Figure 11C

Applicant's election of Species C which comprises of claims 1-15 in the reply filed on 12/09/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The disclosure is objected to because of the following informalities:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. US2003/0016387 hereinafter referred to as Takagi and in view of Nagasaka US2003/0065718.**

**As per Claim 1**, Takagi teaches a printing device that pulls print data to be printed by requesting and obtaining the print data, (Takagi, Figure 1, Component 101 and Figure 2, Component 200)said device comprising:

a print start instruction receiving unit operable to receive location information indicating a storage location of printing instruction information indicating details of a printing instruction to the printing device, (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location, printing instruction information would be considered the print data) the location information being received as an instruction indicating that printing of the print data should be started; (Takagi, Paragraph [0034])

indicated by the location information received by said print start instruction receiving unit; (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location. The process includes extracting url to receive designated print data for printing. By user initiating services includes a print instruction)

a print data request unit operable to request transmission of the print data, based on the printing instruction information; (Takagi, Paragraph [0034], requests print data from designated server)

a print data receiving unit operable to receive the print data requested by said print data request unit; (Takagi, Paragraph [0034], receives print data from designated server to be printed)

and a printing unit operable to print the received print data according to the received printing instruction information. (Takagi, Figure 2, Component 205)

Takagi does not teach a printing instruction information request unit operable to request transmission of the printing instruction information

a printing instruction information receiving unit operable to receive the printing instruction information requested by said printing instruction information request unit;

Nagasaka teaches a printing instruction information request unit operable to request transmission of the printing instruction information (Nagasaka, paragraph [0041], the information being request are the print settings associated with the print data in the form of a settings screen able to manipulate the settings)

a printing instruction information receiving unit operable to receive the printing instruction information requested by said printing instruction information request unit; (Nagasaka, paragraph [0041], user enters print instruction and the transmission controls receives instruction)

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Nagasaka into Takagi. Takagi teaches the ability for the user to initiate the print process but does not allow the user to insert their own personalized instructions that will be sent to communication portion to communicate with the server. Nagasaka teaches an intermediate step that will allow user to modify print instruction prior to sending it to print instruction information receiving unit.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 1.

**As per Claim 2**, Takagi in view of Nagasaka teaches the printing device according to Claim 1, wherein the printing instruction information includes location information indicating a storage location of the print data, and said print data request unit is operable to request the transmission of the print data based on the location information included in the printing instruction information. (Takagi, Paragraph [0034])

Analysis is analogous to that made in Claim 1.

**As per Claim 3**, Takagi in view of Nagasaka teaches the printing device according to Claim 2, wherein the printing instruction information includes print type specification information indicating a print type of the print data, and said printing unit is operable to print the print data based on the print type specification information included in the printing instruction information. (Nagasaka, Figure 5, user designate print type specification such as quality mode which is reflected in the printed data)

Analysis is analogous to that made in Claim 2.

**As per Claim 4**, Takagi in view of Nagasaka teaches the printing device according to Claim 3, wherein said printing instruction information request unit is operable to request the transmission of the printing instruction information when printing based on the printing instruction information becomes ready for execution. (Nagasaka, paragraph [0041], the information being request are the print settings associated with the print data in the form of a settings screen able to manipulate the settings)

Analysis is analogous to that made in Claim 3.

**As per Claim 5**, Takagi in view of Nagasaka teaches the printing device according to Claim 4, wherein a device in which the printing instruction information is stored is different from a device in which the print data is stored, and said printing instruction information request unit is operable to identify the device in which the printing instruction information is stored, based on the location information received by said print start instruction receiving unit, and to request the identified device for the transmission of the printing instruction information. (Takagi, Paragraph [0034], from the extracted url, it will be able to determine the location of the print data in the server, it is only one device therefore it can identify the device which is stored, the print data will be transmitted)

Analysis is analogous to that made in Claim 4.

**As per Claim 6**, Takagi in view of Nagasaka teaches the printing device according to Claim 5, wherein said print data request unit is operable to identify the device in which the print data is stored based on the location information included in the printing instruction information, and to request the identified device for the transmission of the print data. (Takagi, Paragraph [0034])

Analysis is analogous to that made in Claim 5.

**As per Claim 7**, Takagi in view of Nagasaka teaches the printing device according to Claim 6, wherein said print data request unit is operable to request the transmission of the print data over a communication line. (Takagi, Figure 2, Component 231)

Analysis is analogous to that made in Claim 6.

**As per Claim 8**, Takagi teaches a printing instruction device that gives, to a printing device, a printing instruction to print print data, said device comprising:

- a printing instruction input unit operable to accept an instruction, inputted from a user, indicating that the print data should be printed; (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location)

- a printing instruction information storage unit operable to hold the generated printing instruction information; (Takagi, Figure 1, Component 101, fax machine should has some type of memory to store temporarily or permanently print instructions)

- a location information generation unit operable to generate location information indicating a storage location of the printing instruction information; (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location, printing instruction information would be considered the print data)

a location information transmission unit operable to transmit the generated location information to the printing device; (Takagi, Paragraph [0034], receiving service contents including an url regarding storage location, url used to locate print data in server)

a transmission request receiving unit operable to receive, from the printing device, a request for transmission of the printing instruction information indicated by the location information; (Takagi, Paragraph [0034], receives print data from designated server to be printed) and

a printing instruction information transmission unit operable to transmit the stored printing instruction information to the printing device, in response to the request for transmission. (Takagi, Paragraph [0034], receives print data from designated server to be printed)

Takagi does not teach a printing instruction information generation unit operable to generate printing instruction information when the instruction indicating that the print data should be printed is accepted, the printing instruction information indicating details of the printing instruction to the printing device; However Nagasaka teaches it. (Nagasaka, Paragraph [0040], there is a print preview screen which allows the user to customize the print job thus generating print instruction information)

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Nagasaka into Takagi. Takagi teaches the ability for the user to initiate the print process but does not allow the user to insert their own personalized instructions that will be sent to communication portion to communicate with the server. Nagasaka teaches an intermediate step that will allow user to modify print instruction prior to sending it to print instruction information receiving unit.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 8.

**As per Claim 9**, Takagi in view of Nagasaka teaches the printing instruction device according to Claim 8,



wherein said printing instruction information generation unit includes a print data location information obtainment unit operable to obtain location information indicating a storage location of the print data, (Takagi, Paragraph [0034])

and said printing instruction information generation unit is operable to generate the printing instruction information that includes the obtained location information, when the instruction indicating that the print data should be printed is accepted. (Nagasaka, Figure 3 and Paragraph [0040])

Analysis is analogous to that made in Claim 8.

**As per Claim 10**, Takagi in view of Nagasaka teaches the printing instruction device according to Claim 9, wherein said print data location information obtainment unit is operable to receive the location information of the print data from an external device. (Takagi, Figure 2, Component 200 and Component 220, the print data is transmitted from a server that is communicated via a public line network)

Analysis is analogous to that made in Claim 9.

**As per Claim 11**, Takagi in view of Nagasaka teaches the printing instruction device according to Claim 10, wherein said printing instruction input unit includes a print type specification input unit operable to accept an specification, inputted from the user, indicating a print type of the print data, (Nagasaka, Figure 5, user can specify the quality of the print job which is considered print type specification)

said printing instruction information generation unit includes a print type specification information generation unit operable to generate print type specification information for specifying the print type, when the specification indicating the print type is accepted, and said printing instruction information generation unit is operable to generate the printing instruction information that includes the generated print type specification information, when the instruction indicating that the print data should be printed is accepted. (Nagasaka, Figure 3, 5, and Paragraph[0040], user can specify the quality of the print job which is considered print type

specification, information is gathered during preview then when user wants to print by giving an instruction to print, the job is generated to retrieve image data from server)

Analysis is analogous to that made in Claim 10.

**As per Claim 12** Takagi in view of Nagasaka teaches the printing instruction device according to Claim 11, wherein said printing instruction input unit further includes a printing instruction change unit operable to make a change in the already generated printing instruction information that includes the print type specification information, based on an instruction inputted from the user to said printing instruction input unit, (Nagasaka, Figure 5, user can change the print type specification. The print instructions are in default when the print preview comes up)

and said printing instruction change unit is operable to make a change in the already generated printing instruction information stored in said printing instruction information storage unit, in the case where the already generated printing instruction information has not yet been transmitted to the printing device. (Nagasaka, Figure 3, user can change the print type specification until user decides to print that is when instruction is sent to printing device)

Analysis is analogous to that made in Claim 11.

**As per Claim 13**, Takagi in view of Nagasaka teaches the printing instruction device according to Claim 12, wherein said printing instruction change unit is operable to make a change in the print type specification information included in the printing instruction information stored in said printing instruction information storage unit. (Nagasaka, Figure 5, user can change the print type specification. The print instructions are in default when the print preview comes up)

Analysis is analogous to that made in Claim 12.

**As per Claim 14**, Takagi in view of Nagasaka teaches the printing instruction device according to Claim 13, wherein said printing instruction information transmission unit is operable to transmit the printing instruction information after the change in the print type specification information is completed, in the case of receiving the request for transmission of the printing instruction information before the change in the print type specification information is completed. (Nagasaka, Figure 3, 5, and Paragraph[0040], user can specify the quality of the print job which is considered print type specification, information is gathered during preview then when user wants to print by giving an instruction to print, the job is generated to retrieve image data from server. When user specified print, the instruction is transmitted, user will select print the changes wanted are completed.)

Analysis is analogous to that made in Claim 13.

**As per Claim 15**, Takagi teaches a print system comprising a printing device and a printing instruction device, wherein said printing instruction device comprises:

- a printing instruction information storage unit operable to hold the generated printing instruction information; (Takagi, Figure 1, Component 101, fax machine should has some type of memory to store temporarily or permanently print instructions)

- a location information generation unit operable to generate location information indicating a storage location of the printing instruction information; (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location, printing instruction information would be considered the print data)

- a location information transmission unit operable to transmit the generated location information to said printing device; (Takagi, Paragraph [0034], receiving service contents including an url regarding storage location, url used to locate print data in server)

- a transmission request receiving unit operable to receive, from said printing device, a request for transmission of the printing instruction information indicated by the location

information; (Takagi, Paragraph [0034], receives print data from designated server to be printed)and

a printing instruction information transmission unit operable to transmit the stored printing instruction information to said printing device, in response to the request for transmission, (Takagi, Paragraph [0034], receives print data from designated server to be printed) and said printing device comprises:

a print start instruction receiving unit operable to receive the location information indicating the storage location of the printing instruction information, (Takagi, Paragraph [0034] and [0037], user initiates the start of services which will result in receiving service contents including an url regarding storage location, printing instruction information would be considered the print data) the location information being received as an instruction indicating that printing of the print data should be started; (Takagi, Paragraph [0034])

a print data request unit operable to request transmission of the print data, based on the printing instruction information; (Takagi, Paragraph [0034], requests print data from designated server)

a print data receiving unit operable to receive the print data requested by said print data request unit; (Takagi, Paragraph [0034], receives print data from designated server to be printed) and a printing unit operable to print the received print data according to the received printing instruction information. (Takagi, Figure 2, Component 205)

Takagi does not teach a printing instruction input unit operable to accept an instruction, inputted from a user, indicating that print data should be printed;

a printing instruction information generation unit operable to generate printing instruction information when the instruction indicating that the print data should be printed is accepted, the printing instruction information indicating details of a printing instruction to said printing device;

a printing instruction information request unit operable to request transmission of the printing instruction information indicated by the location information received by said print start instruction receiving unit;

a printing instruction information receiving unit operable to receive the printing instruction information requested by said printing instruction information request unit;

Nagasaka teaches a printing instruction input unit operable to accept an instruction, inputted from a user, indicating that print data should be printed; (Nagasaka, Figure 5 and Paragraph [0040])

a printing instruction information generation unit operable to generate printing instruction information when the instruction indicating that the print data should be printed is accepted, the printing instruction information indicating details of a printing instruction to said printing device; (Nagasaka, Paragraph [0040], there is a print preview screen which allows the user to customize the print job thus generating print instruction information)

a printing instruction information request unit operable to request transmission of the printing instruction information indicated by the location information received by said print start instruction receiving unit; (Nagasaka, paragraph [0041], the information being request are the print settings associated with the print data in the form of a settings screen able to manipulate the settings)

a printing instruction information receiving unit operable to receive the printing instruction information requested by said printing instruction information request unit; (Nagasaka, paragraph [0041], user enters print instruction and the transmission controls receives instruction)

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Nagasaka into Takagi. Takagi teaches the ability for the user to initiate the print process but does not allow the user to insert their own personalized instructions that will be sent to communication portion to communicate with the

server. Nagasaka teaches an intermediate step that will allow user to modify print instruction prior to sending it to print instruction information receiving unit.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 15.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MING HON whose telephone number is (571)270-5245. The examiner can normally be reached on Mon- Fri 7:30 to 5:00 EST; 1st Friday Off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571)272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H./  
Examiner, Art Unit 2625

/Mark K Zimmerman/  
Supervisory Patent Examiner, Art Unit 2625

